

Response to Office Action  
Application No. 09/710,962  
Page 4

REMARKS

Pursuant to the Examiner's suggestion attached hereto is a copy of RE37,231 in double column format. Also, Claims 25-28 have been cancelled and Claims 19-22 have been submitted to rectify claim numbering problems.

The Examiner has noted that the present application must be cross-referenced in the parent reissue case. A Certificate of Correction has been issued in the parent reissue case (RE37,231) to satisfy this requirement. A copy of the Certificate of Correction is attached hereto for the Examiner's convenience.

The Examiner has noted that the declaration and consent of assignee incorrectly identify the parent patent. A newly executed Second Supplemental Reissue Declaration of Lars Severinsson and Consent of Assignee of Record Under 37 CFR 3.73 are filed herewith.

The Examiner has rejected Claims 25-28 (now renumbered as 19-22) under the judicially created doctrine of double patenting. A Terminal Disclaimer to Obviate a Double Patenting Rejection is filed herewith.

The Examiner has maintained the earlier rejection of Claim 25 (now renumbered as 19) under 35 U.S.C. 251 as being improper recapture of broadened subject matter. Applicant respectfully disagrees, and suggests that the cover does not relate to surrendered subject matter, as the cover itself was not added and no arguments about the presence of the cover itself were made in an effort to overcome a prior art rejection. Appellant consistently argued for patentability on the basis that the brake mechanism be held together as a unit. The presence of the cover itself was never asserted to contribute to patentability, and indeed it could not have been since the prior art clearly disclosed a brake system having a housing and a cover (see for example U.S. Patent No. 5,927,445 to Bieker, which was brought to the Examiner's attention in the present application via an IDS). Thus, it was Appellant's assertion that a preassembled brake mechanism held together as a unit was patentable. That the preassembled brake mechanism must include a cover was not argued as making the invention patentable, and indeed was not what made the invention patentable. As such, removal of the cover in the present application does not constitute impermissible recapture, as the cover does not relate to surrendered subject matter. If the cover was present, it would form part of the preassembled brake mechanism -- however, there was no argument made that the cover itself was required for novelty or somehow distinguished over the prior art.

Applicant respectfully directs the Examiner's attention to the previously filed Responses and the Appeal Brief for further details of Applicant's contentions.

With respect to the Examiner's concerns that "it remains unclear how the cover can be left out of the picture if the inner workings of the brake mechanism are attached to it for insertion into the housing 'as a unit'", and "that nowhere in the specification does it state these specific elements (bearing tappets and thrust sleeves) are preassembled without the cover", Applicant respectfully submits that this is not a relevant issue. The specification discloses one particular embodiment of the invention which the Applicant considered to be the best mode at the time of filing. That particular embodiment included a cover (It should be noted that embodiments without a cover can be envisioned). However, the Examiner has already indicated that the cover is not required for novelty by specifically indicating that such claims are patentable over the prior art. As such, there is no requirement that the claims require a cover even if the embodiment disclosed in the specification includes a cover.

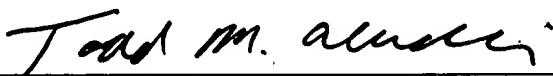
Applicant is not claiming the absence of a cover, in which case, a specific disclosure of an assembly without a cover may be required. Instead, Applicant is

Response to Office Action  
Application No. 09/710,962  
Page 7

simply attempting to obtain a claim which does not specifically require the presence of a cover, because this element is not required for novelty and was never argued as being required for novelty. The Examiner will immediately recognize that every component of an invention need not be required in the claims. In this case, the cover is not required for novelty, and there is no reason it needs to be required by the claims. This was the error in the original claims for which reissue is being sought.

For the foregoing reasons, Applicant respectfully submits that Claims 19-22, all of the claims currently pending, are patentable over the references of record and do not attempt to impermissibly recapture surrendered subject matter, and therefore earnestly solicits allowance of the same.

Respectfully submitted,



---

Wesley W. Whitmyer, Jr., Registration No. 33,558  
Richard J. Basile, Registration No. 40,501  
Todd M. Oberdick, Registration No. 44,268  
Attorneys for Applicant  
ST. ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, CT 06905-5619  
203 324-6155